

Remarks

The present response to the Office Action mailed May 19, 2004, includes the addition of new independent linking claim 15 and dependent claim 16, depending from linking claim 15, and amendments to claims 1-3, 6, and 8-14.

The addition of claims 15 and 16 have been made by the Applicant to more particularly point out and distinctly claim the subject matter considered by the Applicant as his invention, and not for reasons of patentability related to a prior art rejection of the claims. The added new claims, 15 and 16, are each believed to be proper, do not introduce new matter, and serve to place the application in proper condition for consideration and allowance.

Through the amendments made to the language of the hereinabove claims 1-3, 6, and 8-14, each amended claim has been generally broadened in scope to better identify the subject matter regarded by the Applicant as the invention. These amendments have not been made in response to a prior art rejection, are believed to be proper, do not introduce new matter, and serve to place the application in proper condition for consideration and allowance.

Regarding the restriction made by the Examiner to one of the following claim sets:

- I. Claims 1-7, drawn to a method for providing a multilayer disc drive housing structure, classified in class 29, subclass 603.03.
- II. Claims 8-14, drawn to a multilayer disc drive housing, classified in class 360, subclass 97.01.

The Applicant provisionally elects with traverse Group I claims (claims 1-7, and independent linking claim 15 and dependent claim 16) for prosecution on the merits.

Election/Restriction under 35 U.S.C. §121

To be fully responsive to the Office Action and to promote an expedited examination of the application, the issues raised by the Election/Restriction Office Action (Paper No. 6) will now be briefly addressed.

The Applicant respectfully points out that new independent claim 15 is a proper linking claim drafted under the provisions of 35 U.S.C. §112, sixth paragraph. Claim 15

properly links independent claim 1 with independent claim 8. The Applicant further respectfully points out that under MPEP § 809, sixth paragraph, upon allowance of the linking claim, the non-elected claims must be rejoined and fully examined for patentability if the non-elected claim[s] depend from or include all the limitations of the allowable linking claim. In the present case, claims 8-14 are the non-elected claims.

The Examiner is also respectfully reminded that the proper examination of claim 15, requires an identification of the corresponding structure, material, or acts in the specification and equivalents thereof, that carry out the functions recited in the claim, and that 35 U.S.C. § 112, sixth paragraph, applies to the Examiner during prosecution of the patent application. *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1193, 1194 (Fed.Cir.1994)(*en banc*). Pursuant to 35 U.S.C. § 112, sixth paragraph, “structure disclosed in the specification is ‘corresponding structure’ only if the specification or prosecution history clearly associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing 112, paragraph 6.” *B. Braun Medical*, 43 USPQ2d 1896 at 1900.

In accordance with *B. Braun Medical*, *supra*, the Applicant respectfully associates the acts supporting the function called for by the “means plus function” claim element of claim 15, “steps for determining a final characteristic of each of said rigid and visco-elastic damping layers,” to include at least the steps of: developing a plurality of hypothetical models for the housing structure, each model comprising first, second and third theoretical layers wherein at least one of said theoretical layers comprises multiple damping layers; determining a loss factor profile for each said hypothetical model in relation to a resonant frequency of the housing layer; and selecting the final characteristic of each of said rigid damping layers and said visco-elastic damping layers in relation to the determined loss factor profiles. Support for these acts may be found by referring to FIG. 6 as described in the specification beginning on page 16, lines 4-15.

Accordingly, the Examiner is *obliged as a matter of law* to construe the acts, and equivalents thereof, as identified hereinabove by the Applicant, as acts supporting the recited function of the 35 U.S.C. § 112, sixth paragraph element of claim 15. *In re Donaldson Company, Inc.*, 16 F.3d 1189 at 1195 (Fed.Cir.1994)(*en banc*). See also

Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, P6, 65 FR 38510, Federal Register Vol. 65, No. 120, June 21, 2000; and *Means or Step Plus Function Limitation Under 35 U.S.C. 112, P6*, Notice, 1162 Off. Gaz. Pat. Office 59 (May 17, 1994).

By properly construing the acts supporting the recited function expressed by the element of linking claim 15 drafted under the provisions of 35 U.S.C. §112, sixth paragraph, the restriction of claims 1-7 to a first invention, and claims 8-14 to a second and separate invention is an improper restriction. The restriction is improper because, under 37 CFR §1.141(a), and in accordance with MPEP § 806.05(c), the particulars of linking claim 15, needed to show novelty and unobviousness of claim 15, are required by claim 1, and claim 8. That is, because claim 15 is a subcombination (i.e., a narrower embodiment of the invention that includes additional limitations relative to the limitations of claim 1), and claim 1 is a combination (i.e., a broader embodiment of the invention), which requires the particulars of claim 15, the Examiner is precluded from issuing a restriction requiring an election of claims by the Applicant for examination. Similarly, the particulars of linking claim 15 (a subcombination) to show novelty and unobviousness of claim 15, are required by claim 8 (a combination).

Therefore, the Applicant respectfully requests that the Examiner withdraw the present Election/Restriction requirement as drawn to the claims of Groups I and II.

Conclusion

This is intended to be a complete response to the Election/Restriction Office Action (Paper No. 6) mailed May 19, 2004.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

By:



Daniel P. Dooley, Registration No. 46,369

Randall K. McCarthy, Registration No. 39,297

Bill D. McCarthy, Registration No. 26,772

Mitchell K. McCarthy, Registration No. 38,794

Fellers, Snider, Blankenship, Bailey and Tippens, P.C.
Bank One Tower

100 N. Broadway, Suite 1700

Oklahoma City, Oklahoma 73102

Telephone: (405) 232-0621

Facsimile: (405) 232-9659